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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,653	03/23/2001	Diane Pennica	10716-57/CURA233/GN1885R1	6857
23552	7590	05/25/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			NICKOL, GARY B	
			ART UNIT	PAPER NUMBER
			1642	
DATE MAILED: 05/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/816,653

Applicant(s)

PENNICA ET AL.

Examiner

Gary B. Nickol Ph.D.

Art Unit

1642

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-3 and 36-49.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

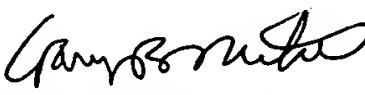
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Attached.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

  
**GARY B. NICKOL, PH.D.**  
**PRIMARY EXAMINER**

Gary B. Nickol Ph.D.  
Primary Examiner  
Art Unit: 1642

*Response to Arguments*

Claims 1, 3 and 36-49 remain rejected under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph (enablement), because the claimed invention is not supported by either a specific asserted utility or a well established utility for the reasons of record (Actions mailed 03/17/2003 11/14/2003 and 02-24-2005. Applicants appear to reiterate their previous rejections; i.e. (1) that it was known in the art that the Wnt signal transduction pathway was involved in human cancer, (2) that upregulation of STRA6 in Wnt-1 expressing cells reasonably demonstrates STRA6 as a candidate gene for diagnosis and therapeutic use in Wnt related cancer. These arguments have been carefully considered but are not found persuasive for the reasons of record. With regards to the argument that expression levels of mRNA do not correlate nor predict equivalent levels of polypeptide expression, applicants argue (Response, page 8) that the examiner failed to present references relating to the Wnt pathway and that how proteins other than those in the Wnt pathway are expressed is immaterial to the present application. This argument has been considered but is not found persuasive as the references underscore what is generally accepted in the art; control of gene expression can occur at multiple stages and production of RNA cannot inevitably be equated with production of protein. Thus, all of applicant's arguments have been carefully considered but are not found persuasive to remove the rejections under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph (enablement).

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Claims 1, 36-38, and 40-42 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons of record. Applicant's arguments have been carefully considered but are not found persuasive for the reasons of record in the Action mailed 11-14-2003.

Claim 47 remains rejected under 35 USC 112, first paragraph, as the specification does not contain a written description of the claimed invention drawn to "yellow fluorescent protein". As set forth previously, there does not appear to be support for the term "yellow fluorescent protein". Applicants proposed amendment would obviate this rejection.

Claim 1 remains rejected under 35 U.S.C. 102(e) as being anticipated (for the the reasons of record) by any one of the following:

(1) Pennica *et al.* US Patent Application No: 20020156252A1, Prior Filing Date: 01-13-2000.

(2) Pennica *et al.* US Patent Application No: 20020173461A1, Prior Filing Date: 01-13-2000.

(3) Baker *et al.* US Patent Application No: 20030149239A1, Prior Filing Dates: 1997, 1998.

(4) Baker *et al.* US Patent Application No: 20030187201A1, Prior Filing Dates: 1997, 1998, 1999.

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(5) Baker *et al.* US Patent Application No: 20030187202A1, Prior Filing Dates: 1997, 1998.

(6) Baker *et al.* US Patent Application No: 20030187203A1, Prior Filing Dates: 1997, 1998.

Applicants have addressed their arguments to the proposed amendments. However, because said amendments were not entered the rejection is maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary B. Nickol Ph.D. whose telephone number is 571-272-0835. The examiner can normally be reached on M-Th, 8:30-5:30; alternate Fri., 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**GARY B. NICKOL, PH.D.**  
**PRIMARY EXAMINER**

Gary B. Nickol Ph.D.  
Primary Examiner  
Art Unit 1642

GBN

A handwritten signature in cursive script, appearing to read "Gary B. Nickol".

Continuation of 3. NOTE: The suggested amendment to Claim 40 "wherein the polypeptide comprises one or more membrane spanning domains" would require further searching as it includes new parameters for consideration. Further, the suggested amendment appears to require further considerations under 35 USC 112 first paragraph. Although applicants point to page 14 of the specification for support, it does not appear that the subject matter is fully disclosed as the specification only recites having "potentially 7-8 membrane spanning domains".